



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Shimoyama et al.

Group Art Unit: 2828

Serial Number: 09/511,188

Examiner: Delma R. Flores Ruiz

Filed: February 23, 2000

Confirmation No.: 4217

For: SEMICONDUCTOR OPTICAL DEVICE APPARATUS

Customer No. 38834

REQUEST FOR RECONSIDERATION OF FINAL REJECTION

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

April 26, 2004

Sir:

Applicants respond herein to the November 19, 2003 Office Action. The period for response thereto is extended by the accompanying Petition for Extension of Time.

• Claims 1, 42-45, 48, and 51-53 stand rejected under 35 U.S.C. §102(b) as anticipated by *Shimoyama et al.* (EP 0 867 949 A2). Applicants respectfully traverse this rejection as improper.

Base claim 1 describes a semiconductor optical device apparatus that has a dielectric protection film with a “stripe-shaped opening” that satisfies either or both of the following conditions (a) and (b):

condition (a): a width (W_C) at an opening center of the stripe-shaped opening is different from a width (W_F) of the opening front end; and

condition (b): a width (W_C) at an opening center of the stripe-shaped opening is different from a width (W_R) of the opening rear end.

Claims 42-45, 48, and 51-53 depend from claim 1, so they also describe a semiconductor optical device apparatus that has a dielectric protection film with such a stripe-shaped opening.

To support an anticipation rejection, the PTO must cite a reference teaching a semiconductor optical device apparatus as claimed. However, applicants have studied the *Shimoyama et al.* disclosure and find no teaching of a semiconductor optical device apparatus that has a dielectric protection film with a stripe-shaped opening as claimed. Furthermore, although the Office Action includes a statement on page 3 explicitly representing that *Shimoyama et al.* teaches the stripe-shaped opening as recited in the claim, the Office Action fails to provide a supporting citation following the statement.

Applicants acknowledge that the Office Action's general citation of Figs. 1-6, the Abstract, and pages 2-10, but this is only a citation of the entire *Shimoyama et al.* document, with the exception of the claims and Fig. 7 (which graphically represents electrical characteristics of the *Shimoyama et al.* semiconductor light-emitting device).

Because the Office Action does not support its statement that the *Shimoyama et al.* "stripe-shape opening" satisfies at least one of the two conditions specified in claim 1, the anticipation rejection of claims 1, 42-45, 48 and 51-53, the Office Action has not been justified. Accordingly, withdrawal of the rejection is now solicited.

Claims 2-41, 46, 47, 49, and 50 stand rejected under 35 U.S.C. 103 (a) as obvious over *Shimoyama et al.* in view of *Adachi et al.* (U.S. Pat. 5,974,068). Applicants respectfully traverse this rejection as improper.

Although not explicitly stated in the Office Action, it is implied that the obviousness rejection relies in part on *Shimoyama et al.* anticipating base claim 1. However, as discussed above, *Shimoyama et al.* cannot properly anticipate claim 1. Therefore, an obviousness rejection based in part on such an anticipation rejection of claim 1 cannot be proper.

For this reason, withdrawal of the obviousness rejection of dependent claims 2-41, 46, 47, 49, and 50 is now solicited.

In view of the remarks above, applicants now submit that the application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for any reason it is believed that this application is not now in condition for allowance, the Examiner is invited to contact applicants' undersigned attorney at the telephone number indicated below to arrange for disposition of this case.

In the event that this paper is not timely filed, applicants petition for an appropriate extension of time. The fees for such an extension, or any other fees which may be due, may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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Enclosure: Petition for Extension of Time

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